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09/150,692	09/10/1998	GARY S. BACHAND	5137	6792

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JOHN A O'TOOLE

P O BOX 1113

MINNEAPOLIS, MN 55440

EXAMINER

BECKER, DREW E

ART UNIT

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 24

Application Number: 09/150,692
Filing Date: September 10, 1998
Appellant(s): BACHAND ET AL.

Alan D. Kamranth
For Appellant

EXAMINER'S ANSWER

MAILED

JUL 29 2002

GROUP 1700

This is in response to the appeal brief filed June 25, 2002.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1-10 and 14-20 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

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(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

WO 97/33822	Laschkewitsch et al	9-1997
3,669,007	Pulici	6-1972
5,853,836	Zoss	12-1998

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

2. Claim 14 is rejected under 35 U.S.C. 102(a) as being anticipated by WO 97/33822.

WO 97/33822 teach a rolled food item comprising a strip of food material (page 6, line 35), a strip of support material (page 7, line 11), rolling the strips together (page 9, line 1), and the food strip having an area at the trailing edge with a greater moisture content

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than the rest of the food strip, provided by an edible adhesive, which holds the roll together during packaging (page 16, line 5).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO 97/33822.

WO 97/33822 teaches the above mentioned concepts. It would have been obvious to one of ordinary skill in the art to use a coverage area of approximately 10% in WO 97/33822 since WO 97/33822 does not recite the amount of edible adhesive used, since WO 97/33822 teaches applying the adhesive to the trailing end only (page 16, line 5), since the coverage area would have been varied depending upon such factors as the type of food and the type of adhesive used, since this amount would have been used during the course of normal experimentation and optimization, and since this would not have materially or patentably affected the invention.

5. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 97/33822 in view of Pulici [Pat. No. 3,669,007].

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WO 97/33822 teach a rolled food item and a method of making a rolled food item comprising a strip of food material (page 6, line 35), a paper strip (page 7, line 11), rolling the strips together (page 9, line 1), and the food strip having an area at the trailing edge with a greater moisture content, provided by an edible adhesive, which holds the roll together during packaging (page 16, line 5). WO 97/33822 does not teach spraying the edible adhesive or the use of water free of adhesive-type additives as the edible adhesive. Pulici teaches a method of producing a rolled food item by spraying water upon the food in order to keep it in a rolled state (column 5, lines 62-65; column 6, lines 58-64). It would have been obvious to one of ordinary skill in the art to incorporate the spraying of Pulici into the invention of WO 97/33822 since both are directed to methods of producing rolled foods, since WO 97/33822 already included applying a drop of edible adhesive (page 16, line 32), since spraying was merely the application of multiple drops of a liquid, since the spraying of multiple drops would have provided a greater area of surface coverage for the edible adhesive and thereby created a stronger bond which would have resisted unrolling better than a single drop, and since edible adhesives were commonly sprayed onto rolled foods as shown by Pulici. It would have been obvious to one of ordinary skill in the art to incorporate the water, free of adhesives, of Pulici into the invention of WO 97/33822 since both are directed to methods of producing rolled foods, since WO 97/33822 already required an edible adhesive, since water was commonly used as an edible adhesive, and since water was commonly known to tackify food materials and prevent unrolling without the use of additives, as shown by Pulici (column 6, lines 58-64). Furthermore, it was commonly known that

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combining water with a starch, such as the dough of Pulici or the fruit material of WO 97/33822, would result in a tackified mass just as syrup was commonly made by combining water with food starch. This would have eliminated the need for corn syrup in WO 97/33822 and thus simplified production by simply using water and the carbohydrates naturally found in the fruit material of WO 97/33822.

6. Claims 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 97/33822 as applied to claim 15 above, in view of Zoss [Pat. No. 5,853,836]. WO 97/33822 teach the above mentioned concepts as well as the food material being dehydrated fruit material (page 7, line 11), and the food strip being cut to the same length as the paper (page 8, line 23). WO 97/33822 does not teach the paper being silicon parchment paper and the paper being wider than the food strip. Zoss teaches a method of making a rolled food product comprising the use of silicon parchment paper (column 3, line 53) and the paper being wider than the food strip (column 3, lines 57-62). It would have been obvious to one of ordinary skill in the art to incorporate the paper structure of Zoss into the invention of WO 97/33822 since both are directed to rolled foods with support materials, since WO 97/33822 already teaches that the support material is paper (page 8, line 5), since Zoss teaches that silicon parchment paper is strong enough to resist tearing without being bulky (column 3, line 55), and since having the paper be wider than the food strip prevents the food strip from rubbing against fabrication equipment as taught by Zoss (column 3, line 63 to column 4, line 3).

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7. Claims 5-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 97/33822 and Pulici as applied to claim 3 above, and further in view of Zoss.

WO 97/33822, Pulici, and Zoss teach the above mentioned concepts. WO 97/33822, Pulici, and Zoss are combined for the above mentioned reasons and since all are directed to the production of rolled foods.

(11) Response to Argument

Appellants make numerous references to a "Cherukuri (Patent No. 4,352,825)" on pages 4-17 of the brief. It should be noted that Cherukuri et al does disclose that confectionary material becomes "sticky and tacky... and tends to stick to its wrap" when its moisture content is increased (column 1, lines 20-25). This reference was not applied to the present rejection and thus is immaterial to the issues at hand.

Regarding claim 14, appellants appear to argue against statements and references (Cherukuri et al) which were not present in the rejection and contends that WO 97/33822 does not teach the use of water. However, claim 14 does not recite "water" but merely a food item with an area of greater "moisture content". The edible adhesive of WO 97/33822 would certainly meet this limitation since syrup was comprised mostly of water and would have been absorbed by the food item. Appellants even admit that the food item of WO 97/33822 would possess an area of greater moisture content on page 6, line 20 of the brief.

Regarding claims 3, 5-10, 15-20, appellants argue that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that

any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). It would have been obvious to one of ordinary skill in the art to use a coverage area of approximately 10% in WO 97/33822 since WO 97/33822 does not recite the amount of edible adhesive used, since WO 97/33822 teaches applying the adhesive to the trailing end only (page 16, line 5), since the coverage area would have been varied depending upon such factors as the type of food and the type of adhesive used, since this amount would have been used during the course of normal experimentation and optimization, and since this would not have materially or patentably affected the invention. It would have been obvious to one of ordinary skill in the art to incorporate the paper structure of Zoss into the invention of WO 97/33822 since both are directed to rolled foods with support materials, since WO 97/33822 already teaches that the support material is paper (page 8, line 5), since Zoss teaches that silicon parchment paper is strong enough to resist tearing without being bulky (column 3, line 55), and since having the paper be wider than the food strip prevents the food strip from rubbing against fabrication equipment as taught by Zoss (column 3, line 63 to column 4, line 3).

Regarding claims 18-19, appellants argue solely against "Cherukuri". However, the present rejection does not even mention this Cherukuri reference. Instead, the

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present rejection of claims 18-19 relies upon WO 97/33822 and Zoss, as discussed above, neither of which is mentioned in appellants' arguments.

Regarding claims 1-2, appellants state that "Examiner Becker apparently recognized the patentability of the present invention". However, there was never any indication of any patentable subject matter in this application, at any point in the proceedings. Furthermore, the change in primary references in paper no. 8 was due solely to the fact that the WO 97/33822 reference was not known to the examiner until after the first rejection of paper no. 4 had been mailed. In addition, the present rejection of claims 1-2 relies upon WO 97/33822 in view of Pulici, whereas the rejection of the original office action (paper no. 4) relied upon Zoss in view of Shapiro. Therefore, the teachings of Shapiro would have no impact upon the present rejection.

Also regarding claims 1-2, appellants argue that WO 97/33822 does not teach applying "water". However, claim 1 recites only "a source of moisture". As described above with regards to claim 14, the syrup of WO 97/33822 was comprised primarily of water, and thus would satisfy the "source of moisture" limitation of claim 1.

Regarding claim 1, appellants' argue that "there is no disclosure that the corn syrup is sprayed or has the ability to be sprayed". However, Pulici was relied upon to teach the step of spraying an edible adhesive (water). As pointed out in the above rejection, it would have been obvious to one of ordinary skill in the art to incorporate the spraying of Pulici into the invention of WO 97/33822 since both are directed to methods of producing rolled foods, since WO 97/33822 already included applying a drop of edible adhesive (page 16, line 32), since the spraying of multiple drops would have

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provided a greater area of surface coverage for the edible adhesive and thereby created a stronger bond which would resist unrolling better than a single drop, and since edible adhesives were commonly sprayed onto rolled foods as shown by Pulici.

Regarding claims 1-8, appellants' argue at various points that Pulici teaches a rolled dough rather than a "sweetened dehydrated fruit-based material". However, these claims recite only a "rolled food item". This limitation would certainly be met by the rolled dough of Pulici as well as the fruit-based material of WO 97/33822.

Regarding claims 9 and 18 which do recite a "sweetened dehydrated fruit-based material", appellants argue that the water of Pulici would not be effective upon the fruit-based material of WO 97/33822. However, sweetened dehydrated fruit-based material was taught by WO 97/33822 at page 7, line 11. Furthermore, it was commonly known that combining water with a starch, such as the dough of Pulici or the fruit material of WO 97/33822, would result in a tackified mass just as syrup was commonly made by combining water with dehydrated food starch. This would eliminate the use of corn syrup in WO 97/33822 and thus simplify production by simply using water and the carbohydrates naturally found in the fruit material of WO 97/33822.

Page 15, line 9 of appellants' brief states that "WO 97/33822 is disclosed as being gum or candy". However, attention is drawn to page 7, line 11 of WO 97/33822 which clearly states that the food is "dehydrated fruit based material".

Page 15, line 22 of appellants' brief states that "Pulici would teach spraying the outer roll layer or to spray the entire food item before rolling as there is no teaching in Pulici that water would be sprayed adjacent to the trailing edge". However, attention is


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drawn to column 5, line 61 of Pulici which clearly states that "The terminal margin of the wrap may be sprayed".

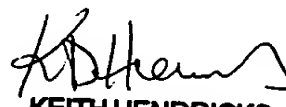
In conclusion, WO 97/33822 teaches rolling a food item with a trailing portion having an area of increased moisture content from an edible adhesive and Pulici teaches spraying water onto a rolled food item as a form of adhesion. It would have been obvious to one of ordinary skill in the art to combine the teachings of WO 97/33822 and Pulici for the above mentioned reasons and also since water was a commonly used food adhesive due its ability to tackify the starches already present in the food item.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


Drew Becker
July 24, 2002

Conferees
Keith Hendricks
Gregory Mills


KEITH HENDRICKS
PRIMARY EXAMINER

JOHN A O'TOOLE
P O BOX 1113
MINNEAPOLIS, MN 55440


GREGORY MILLS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700
Conferee